

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN S. JACKSON and FRANCO TRAVOSTINO

Appeal 2007-2008
Application 09/707,280
Technology Center 2100

Decided: September 4, 2007

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-68 and 71-75, which are all of the claims pending in this application as claims 69 and 70 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants invented a method and an apparatus for providing personalized services to a user based upon the physical presence of the user (Specification 3). An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method for providing a personalized service in a communication system, the method comprising:

detecting physical presence of a user, wherein the detecting includes a determination, based on at least one physical attribute of the user, that the user is currently in close physical proximity to the communication system; and

providing the personalized service to the user based upon the physical presence of the user.

The Examiner relies on the following prior art references:

Theimer	US 5,493, 692	Feb. 20, 1996
McAllister	US 6,104,913	Aug. 15, 2000 (filed Mar. 11, 1998)
Harris	US 6,331,972 B1	Dec. 18, 2001 (filed Feb. 3, 1997)

The rejections as presented by the Examiner are as follows:

1. Claims 1-5, 7-16, 18-24, 26-35, 37-40, 42-48, 50-59, 61-64, 66-68, and 71-75 stand rejected under 35 U.S.C. § 102(e) as anticipated by Harris.
2. Claims 6, 25, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Harris and McAllister.
3. Claims 17, 36, 41, 60, and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Harris and Theimer.

Rather than reiterate the opposing arguments, we make reference to the Briefs and the Answer for the respective positions of Appellants and the Examiner.

We affirm.

ISSUE

To show that the Examiner erred in rejecting the claims under 35 U.S.C. § 102, Appellants' arguments focus on the claimed limitation related to "physical presence of a user" and "physical attribute of the user" and their absence in Harris (Br. 12-13). Appellants argue that the presence of peers or electronic devices in the communication network of Harris cannot be characterized as the claimed presence of users, nor the signal transmitted by these devices is a physical attribute of the user (*id.*). Therefore, specifically, the issue is whether the claimed physical presence of a user and the physical attribute of the user are the same as the electronic devices and the communication link established therebetween as disclosed in Harris.

FINDINGS OF FACT

The following findings of fact (FF) are believed to be supported by a preponderance of the evidence.

1. Appellants' claim 1 requires the step of "detecting physical presence of a user" by determining based on at least "one physical attribute of the user."
2. Appellants' Specification describes that the claimed detecting step can utilize any user detection/identification techniques such as "a

personal identification number entered through a key pad” or “an access card swiped through a card reader” (Specification 13:24-31).

3. Harris discloses self-initiated communications among electronic devices or peers once they are in particular proximity to one another and a communication link is established (col. 6, ll. 21-33). Harris provides for exchanging needs and capabilities information between the at least two peers when a link is established (col. 6, ll. 35-45).

4. Harris further describes examples of appliance circuits that may be included in a peer such as Personal Digital Assistants (PDAs), telephones, and other electronic devices (col. 8, ll. 34-44) and their corresponding I/O devices including keyboards, pointing devices, optical scanners, and other known devices (col. 8, ll. 56-64).

5. Harris discloses that the electronic devices may be personalized such that whenever that user is near, without requiring any action by the user, the personalized service is provided (col. 10, ll. 7-16).

6. McAllister describes providing personalized service to a subscriber who is identified using a speaker identification/verification procedure (col. 8, ll. 62-65). Other biometric characteristics of the user such as a finger or hand print may also be used for identifying the user (col. 8, l. 65 – col. 9, l. 3).

7. Theimer discloses a User Agent for managing information about a particular user (col. 9, ll. 42-47) which, among other tasks, maintains the user profile and calendar of schedules and sends reminder notes to the user according to the various circumstances set by the user (col. 10, ll. 28-38).

PRINCIPLES OF LAW

A rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. *See Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

ANALYSIS

Based on our findings related to the teachings of Harris, we disagree with Appellants that the physical presence of a user cannot be detected based on the proximity of the peer that is associated with a user (Reply Br. 5-7). In fact, the claims do not specifically delimit the term “physical” to anything other than “actual presence” while the broadest reasonable interpretation of “physical attribute” allows for attributes that actually and materially exist. Our findings are consistent with Appellants’ disclosure where, without mentioning “physical,” various detection mechanisms are described. Examples of user detection/identification techniques disclosed by Appellants include, among others, entering a personal identification number through a key pad and swiping an access card through a card reader (FF 2).

We also disagree with Appellants (Reply Br. 8-10) that a user’s presence is inferred when the link is established only if the user happens to actually be near the peer device since, as determined above, the user is present when certain devices such as a personal digital assistant (PDA) is the peer (FF 3-5). As such, the user’s presence is detected when the user nears

the device or another peer while the user is holding a PDA or is entering an identification number in a key pad.

Appellants' arguments (Br. 13) that user presence in Harris is not based on a physical attribute of the user are also unconvincing since the user identification or personalized data that are used to define the user in Harris (FF 4 & 5) are indeed physical or material attributes of the user. Additionally, as argued by the Examiner (Answer 28), the broadest reasonable interpretation of the claimed term "physical attributes" reads on the personalized information disclosed in Harris that identifies a user/owner of a peer device by virtue of having identification data unique to that user/owner (FF 5).

CONCLUSION

In view of the analysis above, we find that the Examiner's claim interpretation and prior art analysis presented in support of the rejection are convincing of anticipation of claim 1. We also note that Appellants have not presented any substantive arguments directed separately to the patentability of independent claims 21, 45, and 71 as well as dependent claims 2-5, 7-16, 18-20, 22-24, 26-35, 37-40, 42-44, 46-48, 50-59, 61-64, 66-68, and 72-75 (Br. 12-15). In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d at 590, 18 USPQ2d at 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the Examiner's 35 U.S.C. § 102 rejection of these claims as being anticipated by Harris.

With respect to the rejection of claims 6, 25, and 49, Appellants rely on the same arguments presented for claim 1 discussed above and on failure

of McAllister is curing the deficiency of Harris (Br. 15-17). Similarly, with regard to the rejection of claims 17, 36, 41, 60, and 65, Appellants argue the absence of teachings related to the “physical presence” and “physical attributes” of the user in Theimer (Br. 18-20). Based on our findings above with respect to Harris, we find the Examiner’s position to be reasonable and sufficient for one of ordinary skill in the art to combine the references to arrive at the claimed invention. Accordingly, we sustain the 35 U.S.C. § 103 rejection of claims 6, 25, and 49 over Harris and McAllister and of claims 17, 36, 41, 60, and 65 over Harris and Theimer.¹

¹ We observe that claim 45 is directed to a “computer readable medium,” which is described in the Specification to include “a signal that is transmittable to a computer using any of various communications technologies, including ... wireless” (Specification 40). The breadth of the claimed medium allows for signals and could render the claim non-statutory. We are not aware of any case law that has specifically decided this question either way. However, *see, e.g., Ex Parte Hartmann*, No. 2006-1607, 2006 WL 2700810, at 4 (B.P.A.I. 2006) (non-precedential) (“‘Signals’ are not statutory subject matter. Additionally, a case involving this issue is presently on appeal to the Federal Circuit: *In re Nuijten*, No. 06-1301.”); *see also* “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” 1300 Off. Gaz. Pat. Office 142, Annex IV(c) (Nov. 22, 2005). It could be argued that a carrier wave or signal is not statutory subject matter because it does not fall within any of the four categories of statutory subject matter. Even if a carrier wave or signal could be considered to be an article of manufacture, however, we find that such a carrier wave or signal does not operate as the claimed computer program product. Claim 45 recites a computer program product including a computer program carrying instructions for performing a series of steps. It is our view that the computer cannot perform the claimed functions while the instructions are within a carrier wave or a signal.

DECISION

The decision of the Examiner rejecting claims 1-5, 7-16, 18-24, 26-35, 37-40, 42-48, 50-59, 61-64, 66-68, and 71-75 under 35 U.S.C. § 102 and of claims 6, 17, 25, 36, 41, 49, 60, and 65 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

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